To:	ADVANTEST CORPORATION (VDELRIO@S-N-H.COM)
Subject:	TRADEMARK APPLICATION NO. 76235496 - SILICON FINGER - 1526.2002 (D
Sent:	7/6/2005 11:17:32 AM
Sent As:	ECOM101@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/235496

APPLICANT: ADVANTEST CORPORATION

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Alexandria, VA 22313-1451

MARK: SILICON FINGER

CORRESPONDENT'S REFERENCE/DOCKET NO: 1526.2002 (D

CORRESPONDENT EMAIL ADDRESS:
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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 76/235496

This letter responds to the applicant's communication filed on 3 May 2005.

Supplemental Register
Registration was refused under Trademark Act Section 23, 15 U.S.C. Section 1091, because the proposed mark is incapable of identifying the applicant's goods and distinguishing them from those of others.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 23 is maintained and made FINAL.

A generic term is the apt or common descriptive name of a class or genus of goods or services and does not serve as an identification of the source of those goods or services. The court in *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986) used a two-step test to determine whether a mark was generic. The first step is what is the genus of goods or services at issue. The second step is to determine whether the term sought to be registered is understood by the relevant public primarily to refer to that genus of goods or services. An analysis of these two points follows.

The applicant's selection of the term, SILICON FINGER, is the apt or common descriptive name of a class or genus of goods. The applicant's goods are contactors and contactor probe cards, made of Micro-Electro-Mechanical Systems (MEMS) material including mechanical elements, sensors, actuators, and electronics on a common silicon substrate, for use in testing equipment to test electronic circuits and electronic devices, namely, semiconductor wafers, integrated circuits, printed circuit boards, semiconductor chips, and packaged semiconductor devices. The applicant's proposed mark immediately and unequivocally describes a key feature of the goods. The term immediately identifies that the applicant's probe cards are comprised of silicon fingers. In *In re Gould Paper Corporation*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), the court stated, "Gould has simply joined the two most pertinent and individually generic terms applicable to the product, and then attempts to appropriate the ordinary compound thus created as its trademark." Like the proposed mark in *Gould*, the applicant's proposed mark immediately and unequivocally describes the purpose, function and nature of the goods.

A term that serves as the common descriptor of a key ingredient, characteristic or feature of the goods is also generic and thus incapable of distinguishing source. A term need not relate solely to the name of the goods or services in order to be held incapable of serving as an indicator of origin. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986) (CHOCOLATE FUDGE generic for diet sodas); *Miller Brewing Co. v G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977) (LITE generic for beer), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (PASTEURIZED for face cream incapable); *Roselux Chemical Co, Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (SUDSY generic for ammonia); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (ART DECO generic for flatware); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for stores that sell lingerie); *In re National Patent Development Corp.*, 231 USPQ 823 (TTAB 1986) (ULTRA PURE for interferons for medical use incapable); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of wicker furniture and accessories); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *In re Bee Pollen From England Ltd.*, 219 USPQ 163 (TTAB 1983) (BEE POLLEN FROM ENGLAND for bee pollen incapable).

The second step in an analysis of genericness of a proposed mark is whether the term is understood by the relevant public as referring to that genus of goods or services. The relevant public would be persons who are in the semiconductor industry and are looking for automated test equipment. The public when seeing applicant's proposed mark on the contactors and contactor probe cards would immediately know the goods feature silicon fingers. Attached is an additional article that explains the applicant's use of silicon fingers on its products. Evidence of the public's understanding of a term may be obtained from any competent sources, such as purchaser testimony, surveys, dictionaries, trade journals, newspapers and other publications. *In re Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). The evidence of record includes Nexis articles, Internet websites and dictionary definitions. As was shown by the evidence, the term silicon finger has a specific meaning as used in the testing equipment

for the semiconductor field.

Based on the above, the refusal to register the proposed mark on the Supplemental Register is maintained and made FINAL.

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

(1) Submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or

(2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of $100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is $100. 37 C.F.R. §2.6(a)(15).

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HOW TO RESPOND TO THIS OFFICE ACTION:

- ONLINE RESPONSE: You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit http://www.uspto.gov/teas/index.html and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- REGULAR MAIL RESPONSE: To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at http://portal.uspto.gov/external/portal/tow.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at http://www.uspto.gov/main/trademarks.htm

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

May the Micro Force Be With You

By Ivan Amato

Cheap as Chips

One reason for the excitement is that while microelectronics semiconductor chips are great at logic and memory, they are a brain without a body. "Computers think and think and think. But MEMS are becoming the eyes, ears, noses, mouths, hands and feet of computers," says Markus. Adds Barbour: "All of the electronic components end up passive, but MEMS can respond to all kinds of inputs-chemical, light, heat, pressure, vibration, acceleration-all of the things that just about everybody needs to measure in just about every physical system that we have."

These advantages of MEMS would be enough to entice researchers, but not enough to get MEMS devices onto the market. Yet another factor has also entered the picture: These systems are no longer exotic items that take microengineering specialists months to fabricate. TI's micromirror arrays are, for example, made using lithographic techniques adapted from the microelectronics industry. Technicians start with silicon wafers, spin on thin coatings of polymer photoresists (a photosensitive material), expose plots of the photoresist to light through a stencil-like mask, and wash away the exposed photoresist to reveal a pattern of the underlying wafer that matches the pattern on the mask. After they expose the naked wafer surface, MEMS makers then etch into, around and underneath the surface, diffuse ions into the silicon, or deposit materials such as aluminum onto it. Clever sequences of masks, etching and deposition yield tiny 3-D structures that move on command.

Make no mistake: It's still not easy. But the reliance on standard fabrication tools means manufacturing technology is already in place and, once you design a MEMS device, you can potentially turn them out as cheaply as semiconductor

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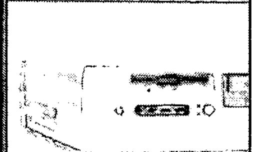

chips. At Analog Devices, headquartered in Norwood, Mass., some 1 million tiny accelerometers are fabricated every month, according to Jeffrey Swift, director of engineering for the company's micromachined products. Buy a car today, and there's almost a 50-50 chance that one of Analog Devices' accelerometer-based sensors (each about the size of the period at the end of this sentence) will be inside the air bag systems.

Prior to micromachined accelerometers, motion sensors in air bags required up to five fist-sized components, each costing about $18. Analog Devices and several competitors sell MEMS accelerometers for less than $10 apiece, reflecting the companies' ability to make them in huge batches. The accelerometers are relatively simple-suspended rectangular slabs of silicon with fingers extending out to form what looks like a double-sided comb. The fingers of these combs mesh with silicon fingers machined into the surrounding silicon framework. The normal motion of a car, as well as the violent and jerky motion during the split second of a crash, instantly sets the suspended accelerometer in motion. The overlapping areas of the meshed silicon fingers change, which causes instantaneous changes in the structure's electrical capacitance. Those electrical changes then feed into circuitry programmed to discern potentially deadly crashes from potholes; when appropriate, the circuitry triggers the release of the air bag.

Analog Devices' engineers are developing MEMS for other emerging automotive applications such as side-impact air bags. And Swift, a father of three boys, including a new driver, suggests another possibility: "What if you had a sensor in the car that your teenager was driving that would tell you how many g forces the car experienced? Did he peel out or do a harsh stop or go around corners at really high speeds?"

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